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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,178	12/21/2001	Alfred Busch	CM2176	1305

27752 7590 09/05/2003

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EXAMINER

HARDEE, JOHN R

ART UNIT PAPER NUMBER

1751

DATE MAILED: 09/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicati n No. 10/019,178	Applicant(s) BUSCH ET AL.	
	Examiner John R Hardee	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-24, drawn to reaction products of aminoaryl derivatives.

Group II, claim(s) 1-24, drawn to reaction products of amino acids and derivatives.

Group III, claim(s) 1-24, drawn to reaction products of substituted amines.

Group IV, claim(s) 1-24, drawn to reaction products of substituted amides.

Group V, claim(s) 1-24, drawn to reaction products of glucamines.

Group VI, claim(s) 1-24, drawn to reaction products of dendrimers.

Group VII, claim(s) 1-24, drawn to reaction products of polyvinylamines, derivatives or copolymers thereof.

Group VIII, claim(s) 1-24, drawn to reaction products of alkylene polyamine.

Group IX, claim(s) 1-24, drawn to reaction products of polyoxyethylene bis amine or aminoalkyl.

Group X, claim(s) 1-24, drawn to reaction products of aminoalkyl piperazine and derivatives.

Group XI, claim(s) 1-24, drawn to reaction products of bis (aminoalkyl) alkyl diamines.

Group XII, claim(s) 1-24, drawn to reaction products of polyethyleneimines.

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Group XIII, claim(s) 1-24, drawn to reaction products of 1,4-bis-(3-aminopropyl)-1,3-piperazine.

2. The inventions listed as Groups I-XIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Any feature which unites the inventions fails to make a contribution over the prior art in view of the reference marked "X" in the PCT Search Report.

3. During a telephone conversation with Mr. Jim McBride on July 31, 2003 a provisional election was made with traverse to prosecute the invention of Group XII, claims 1-20, 22 and 23. Affirmation of this election must be made by applicant in replying to this Office action. No claims were withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, but the claims were searched and examined only to the extent that they read upon the elected invention. No claims can pass to issue until all non-elected subject matter has been deleted from the claims.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

5. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compositions which result in the formation of

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particles, does not reasonably provide enablement for use of any and all carriers with melting points of less than 30 degrees C. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or practice the invention commensurate in scope with these claims. Some particle forming step appears to have been omitted from the recited process. For instance, GB 2,102,292 A discloses a composition comprising the reaction product of an aqueous solution of polyethyleneimine with aldehydes, but it doesn't appear that any particle formation is inherent in the process.

6. Claims 21 and 22 provide for the use of an amine reaction product, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 21 and 22 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Double Patenting

7. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 10/019,177. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '177 recite a process as claimed presently, except that the amine reaction product is mixed with an acid carrier, rather than a carrier with a melting point below 30 degrees C. As there are acids with melting points lower than this, it would have been obvious at the time the invention was made to use such a carrier, because the present claims recite carriers with a melting point below 30 degrees C, and acids with such melting points exist.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Any prior art made of record and not relied upon is of interest and is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (703) 305-5599. The examiner can normally be reached on Monday through Friday from 8:00 until 4:30. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (703) 308-4708.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read "J. Hardee", with a stylized, cursive script.

John R. Hardee
Primary Examiner
September 2, 2003